THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD W. MILLER

Appeal No. 98-1532
Application No. 08/438,533[1]

ON BRIEF

Before ABRAMS, FRANKFORT and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1, 3 and 4. Claim 2 has been canceled. No claims have been allowed.

[1] Application for patent filed May 10, 1995.

The appellant's invention is directed to a cover for a lawn sprinkler head. The claims before us on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Block	2,751,250	Jun. 19, 1956
Leite *et al.* (Leite)	5,211,338	May 18, 1993

THE REJECTIONS

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Leite in view of Block.

Claims 3 and 4 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Leite in view of Block.

The rejections are explained in Paper No. 5, the final rejection.

The arguments of the appellant in opposition to the examiner's positions are set forth in the Brief and the Reply Brief.

OPINION

According to the appellant's specification, a problem in typical home lawn sprinkler installations is that the poppet sprinkler heads, which move from a retracted to an extended position upon the application of water pressure, are easily damaged by being stepped upon or contacted by mowers or other rolling equipment. The objective of the appellant's invention is to provide an effective cover for such sprinkler heads that is simple in design, inexpensive to produce, and easy to install. As manifested in claim 1, the sole independent claim, the appellant's inventive cover comprises a single molded piece forming a circular disk having a dome shaped upper surface and a flat bottom surface. The disk has a central aperture of "predetermined" diameter which is sufficient to allow the operating portion of the sprinkler head to "freely penetrate" the aperture when operating. At least three conically shaped posts are attached to the bottom surface of the disk to anchor the device to the ground. Claims 3 and 4 add to claim 1 details of the posts.

The examiner has rejected all of the claims as being unpatentable over Leite in view of Block. We have evaluated

this on the basis that the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather

than the lack thereof (see *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)).

Leite is directed to a "shield" for a sprinkler in a lawn system, the function of which is to "afford protection and minimize vegetation growth about the sprinkler head" (column 1, lines 9 and 10). The nature of the "protection" provided by the inventive shield to the sprinkler head is not explained. The shield is described as "a rigid cylindrical plate 11 including a planar top surface 12 spaced from and parallel to a planar bottom surface 13," which has a central bore 15 with a plurality of radial slots 16 extending from the bore "to effect flexure in the plate construction in accommodating a sprinkler head to be received therethrough." A plurality of frangible grooves 17 are provided in the plate to permit segments to be broken off so that the device can be fitted to corner and edge installations. See column 3, lines 36-53. The plate is anchored by a plurality of spikes 14.

Block discloses a sprinkler "guard" which comprises a pair of interrelated elements 5 and 6 that together define a dome-shaped plate having a central aperture through which a sprinkler head 1 extends. See Figure 2. The primary purpose

of this guard is to "prevent the growth of weeds and grass around the head," "without in any way altering, adding to or removing from the conventional sprinkler head" (column 1, line 30 *et seq.*). Listed as an objective is draining water away from the sprinkler head to promote this purpose (column 1, lines 59-65), which no doubt is accomplished by its dome shape. The guard is described as being for use with systems in which the sprinkler is "about flush with the upper surface of the ground so that it will not injure a lawn mower nor be injured thereby, and so that it will not be obtrusive or be objectionable to persons walking over the lawn" (column 2, lines 12-15). The sprinkler heads may include the type that move upwardly under the pressure of the water (column 2, lines 16-18). As shown in Figure 2 and described in column 2, the Block device is placed in a depression dug into the ground in such a position as to have the top of the dome flush with the surface of the ground, and is installed around the sprinkler by separating the two plates and then attaching them together so that they "snugly engage the sides of the head" (column 3, lines 19-20).

The examiner has taken the position that Leite discloses all of the subject matter recited in claim 1 except for the domed upper surface and "an aperture diameter sufficient for the sprinkler head" (Paper No. 5, page 2-3), which we interpret to mean an aperture that allows the sprinkler head to "freely penetrate the aperture when operating," as is required by

claim 1. The examiner continues on page 3:

> Block is relied upon merely to show that it is known in the art to provide a dome shaped upper surface 5, 6. It would have been obvious . . . to have provided the circular disk of Leite with a dome shaped upper surface like that of Block, in order to drain the water away from the sprinkler head. . . .[I]t would have been an obvious matter of design choice dependent on such considerations as cost and strength, as well as ease of setup for a particular size of sprinkler head, to make the central bore 15 of Leite with an aperture the size of or a size larger than a diameter sufficient for the sprinkler head to freely penetrate . . . when operating.

We do not agree with the examiner's reasoning or conclusion. We begin our rationale for arriving at this decision by pointing out that neither of the references has recognized the problem to which the appellant has directed his inventive efforts nor, in our view, is there any evidence which would support the conclusion that the combined teachings

of the references would have resulted in structure that solves this problem. In this regard, the upper surface of the shields of both Leite and Block are flush with the surface of the ground, and therefore are incapable of protecting a sprinkler head that is above the ground.

With this as prelude, we direct attention to the requirement in claim 1 that the cover comprise "a single molded piece" that has a dome shaped upper surface and a flat bottom surface. The Leite device is a circular disk comprising a single piece which has a flat upper surface and a flat bottom surface. Block is of multiple piece construction, and has a dome shaped upper surface and a dome shaped bottom surface. From our perspective, even if there existed proper suggestion to combine these references, the result would not be a single molded piece device, as required by the claim but, at best, the dome of Block installed upon the flat disk of Leite, and the rejection fails at this point. And, continuing on this theme, since both references teach providing a central aperture of such diameter as to grip (Leite) or engage (Block) the sprinkler, the combined teachings would not have motivated one of ordinary skill in the art to make the aperture large

enough to permit the sprinkler head to "freely penetrate" it when operating, as is recited in claim 1.

Insofar as the issue of suggestion to combine is concerned, the advantage of Block upon which the examiner based the suggestion to combine the references is its domed upper surface, which allows water to run off from the sprinkler. To incorporate this feature into Leite would require that the flat Leite disk be modified into a domed configuration. Essentially, the result of that would be the Block device, which is where we began this exercise, for we can see no reason to retain the flat bottom surface of the Leite disk in view of the fact that its function of keeping grass from growing close to the sprinkler is accomplished by the domed top of Block. We therefore fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify Leite in the manner proposed by the examiner.

For the reasons expressed above, it is our opinion that the combined teachings of the two applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter of independent claim 1. It therefore follows

that the rejection of that claim and dependent claims 3 and 4 will not be sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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